

REMARKS

Status of the Claims

Claims 22, 25, 26, 28-30, 32-39, and 57-88 are pending in this application, with claims 22, 57, 70, and 84 being independent. In the Office Action dated December 3, 2004, the Examiner rejected claims 22, 30, 34, 57, 64, and 68 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,833,631 to Nguyen. In addition, the Examiner rejected every pending claim under 35 U.S.C. § 103(a) in view of various combinations of U.S. Patent No. 5,622,184 to Ashby et al., U.S. Patent No. 5,924,998 to Cornelius et al., U.S. Patent No. 6,139,540 to Rost et al., U.S. Patent No. 5,833,631 to Nguyen, U.S. Patent No. 5,885,227 to Finlayson, U.S. Patent No. 5,947,940 to Beisel, U.S. Patent No. 5,997,517 to Whitbourne, and U.S. Patent No. 6,245,030 to DuBois et al. By this Amendment, Applicants have amended independent claim 22. Applicants also include new claim 89. In so far as the Examiner deems the rejections of the most recent Office Action applicable to the claims as currently presented, Applicants respectfully traverse and request reconsideration and allowance of the application for the following reasons.

Claims 22 and 57 Are Not Anticipated by Nguyen

In the Office Action, the Examiner rejected each of claims 22, 30, 34, 57, 64, and 68 as allegedly anticipated by Nguyen. Independent claim 22 as amended recites, *inter alia*, a guide wire having an elongate core including a length, a proximal portion, and a distal portion. The guide wire further includes a continuous coil that surrounds a substantial portion of the length of the core and extends distal of the distal portion of the core. A polymeric tip contacts and extends from a distal portion of the coil, wherein the

tip connects to the core by a polymeric material that extends between adjacent turns of the coil.

Nguyen does not disclose or suggest, in any of its embodiments, at least the feature of a polymeric tip that connects to the core by a polymeric material that extends within spaces between adjacent turns of the coil, as recited in claim 22. Instead, Nguyen discloses a guide wire (items 100, 200 and 300) including a core (item 102) and a coil (items 106, 108, 110, 204, 308 and 310). The wire further includes fibrous elements that may be formed of polyester (items 104, 202, and 302). In all three embodiments illustrated in FIGS. 1-3, the fibrous elements *extend beneath* the coil (see, for example, column 4, lines 36-38 of Nguyen) and do not extend within spaces between adjacent turns of the coil, as claimed. Figures 1-3 of Nguyen clearly show that spaces between adjacent turns of the coil are not filled with polymeric material.

Applicants also traverse the rejection of independent claim 57 as allegedly being anticipated by Nguyen. Independent claim 57 recites, *inter alia*, a guide wire having an elongate core including a length and a constant diameter along the length. Nguyen does not disclose or suggest, in any of its embodiments, at least the feature of an elongate core having a constant diameter along its length. Applicants respectfully disagree with the Examiner's assertion that "[t]he core as disclosed by Nguyen includes a constant diameter length." (December 3, 2004 Office Action, p. 2). To the contrary, in all three embodiments illustrated in figures 1-3, the core wire 102 is disclosed as being tapered to a point at the wire's distal end. The passages of column 4, lines 32-34 of Nguyen expressly disclose that "[c]ore wire (102) is shown to be tapered to a point and to have a continuous taper throughout the length of the figure."

Applicants recognize that column 5, lines 2-5 of Nguyen discloses that more than one coil may be used, for example in the embodiment of figure 3, in order to “provide a more constant diameter for the *overall guidewire assembly*.” (Emphasis added). A more constant diameter of the overall assembly, however, cannot provide the basis for the recitation of an *elongate core* having a constant diameter along the length, as recited by independent claim 57, a feature which Nguyen expressly teaches against.

For at least the reasons presented above, Nguyen does not disclose or suggest the invention as recited in independent claims 22 or 57. Accordingly, Applicants respectfully request that the Section 102(e) rejection of independent claims 22 and 57 and their dependent claims 30, 34, 64, and 68 be withdrawn.

Claims 22, 28, and 30 Are Not Obvious Over Ashby et al. in View of Cornelius et al.

In the Office Action, the Examiner rejected each of claims 22, 28, and 30, under 35 U.S.C § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,622,184 to Ashby et al. (“Ashby”) in view of U.S. Patent No. 5,924,998 to Cornelius et al. (“Cornelius”). Independent claim 22 as amended recites, *inter alia*, a guide wire having an elongate core including a length, a proximal portion, and a distal portion. The guide wire further includes a continuous coil that surrounds a substantial portion of the length of the core and extends distal of the distal portion of the core. A polymeric tip contacts and extends from a distal portion of the coil, wherein the tip connects to the core by a polymeric material that extends within spaces between adjacent turns of the coil.

Applicants respectfully traverse the Examiner's rejection of claims 22, 28, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Ashby et al. in view of Cornelius et al. Neither reference, taken alone or in combination, teaches or suggests each and every element of independent claim 22. In particular, the applied references at least fail to disclose the claimed combination including "a polymeric tip contacting and extending from a distal portion of the coil."

Ashby teaches a guide wire 10 having a core 16 and a spring 30 at end 21 of the core 16 to form the core/spring subassembly 50. A sheath 61 is loaded over the core/spring assembly 50, and along with adhesive 85, fully encloses the core/spring subassembly 50. Ashby, however, does not disclose or suggest at least "a polymeric tip contacting and extending from a distal portion of the coil." The Examiner has alleged that the adhesive 85 and spring 30 respectively constitute the polymeric tip and coil recited in claim 22. Adhesive 85, however, does not contact and extend from spring 30. Instead, adhesive 85 plugs an open end of sheath 61, see Fig. 8 and col. 6, lines 54-57, and does not contact spring 30.

The Examiner has relied on Cornelius solely for the alleged teaching of stainless steel and nickel-titanium alloys being art-recognized equivalents. Thus, the Examiner's proposed combination of Ashby and Cornelius does not suggest each and every recitation of independent claim 22, and, therefore, claim 22 and its dependent claims 28 and 30 are allowable over these references.

Rejections Under 35 U.S.C. § 103(a) Applying Nguyen

In addition to the rejections discussed above, the Examiner also rejected each of claims 22, 25, 26, 28-30, 32-39, and 57-88, relying in part on the reference of Nguyen. (December 3, 2004 Office Action, pp. 3-6). The Nguyen reference is being relied on as prior art under 35 U.S.C. § 102(e). Since this application was filed after November 29, 1999, under the provisions of 35 U.S.C. § 103(c), an obviousness rejection under 35 U.S.C. § 103(a) can be overcome by showing that the subject matter of the Nguyen reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Applicants supply a statement on a separate sheet of this response, made by Applicants' representatives, regarding the ownership of this application and the Nguyen reference.

Without in anyway conceding the appropriateness of the Section 103 rejections, Applicants respectfully submit that, in light of this statement, the Section 103(a) rejections utilizing Nguyen should be withdrawn.

Applicants' Representative of Record Statement of Common Ownership
Under M.P.E.P. §706.02(I)(2)

Under the provisions of M.P.E.P. §706.02(I)(2), Applicants' undersigned representative of record supplies the following statement to the effect that this application and the Nguyen patent (U.S. Patent No. 5,833,631) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same organization:

This application, U.S. Patent Application No. 09/597,179 filed June 20, 2000, (which claims priority to U.S. Patent Application 09/078,946 filed May 14, 1998) in the name of Maura Rooney et al., and U.S. Patent No. 5,833,631, filed as U.S. Application No. 08/671,871 on June 28, 1996, in the name of Kim Nguyen, were, at the time the invention of this application was made, both owned by the same parent company, Boston Scientific Corporation, or subject to an obligation of assignment to Boston Scientific Corporation.

Conclusion

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise,

Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, and drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants believe they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

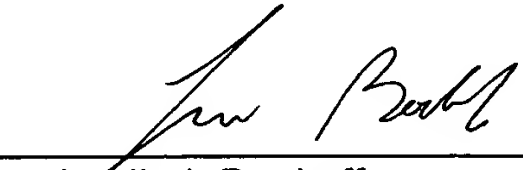
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 2, 2005

By: 

Leslie I. Bookoff
Reg. No. 38,084